

REMARKS

Applicants appreciate the detailed examination evidenced by the Office Action mailed August 23, 2004. Applicants have amended Claims 1-11, 13-15, 18, 24-25, and 27-32, and respectfully submit that the pending claims are patentable over the cited references for the reasons provided below. No new matter has been introduced by these amendments.

Claim Amendments unrelated to the Rejections

Claims 1-3, 18, and 27-30 have been amended to eliminate recitations of "step" in the method claims. Claim 32 has been amended to eliminate "means for" language in the computer program product claim.

Independent Claims 1, 27, 30, 31, and 32 are Patentable Over Nagami

Claims 1-5, 27-28, and 30-32 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,548,58 to Nagami. Amended Claim 1 recites:

1. A method of enhancing document transcoding, comprising:
 - specifying one or more annotations that indicate one or more conditions for when they are to be inserted into a document; and
 - selectively inserting the specified annotations in a target document based on whether the indicated one or more conditions are satisfied, thereby preparing the target document for enhanced transcoding.

Accordingly, an annotation indicates under what condition(s) it is to be inserted into a document. The annotation is then selectively inserted into a target document based on whether the indicated condition(s) is satisfied. The target document can thereby be prepared for enhanced transcoding.

The Specification explains that by "marking annotations in annotation files with target characteristics ..., [then] the annotation(s) [may be selected based on whether they] are applicable for a particular situation (such as selecting one or more annotations that are marked as being applicable to a particular target device, or to a particular type of user agent, and so forth)". (Specification, Page 24, lines 11-15.) The Specification describes an exemplary embodiment in which "one external annotation file may define annotations that may be applied to any structured document containing image files, while another external

annotation file may contain annotations that are only useful to a structured document which contains a particular sequence of tags." (Specification, Page 24, lines 15-18.)

Nagami describes a "machine translation apparatus for translating a document including at least one tag". (Nagami, Col. 2, lines 5-6.) The machine "comprises a definition file for converting the tag into supplementary translation information", and "a supplementary translation information adding unit for adding the supplementary translation information for the tag, into the document in accordance with the definition file." (Nagami, Col. 2, lines 6-11.) In contrast to the recitations of Claim 1, the translation apparatus of Nagami always adds supplementary translation information for a tag into the document. Nagami provides no description of an annotation that can indicate one or more conditions for when it is to be inserted into a document, and it also provides no description of selectively inserting an annotation into a document based on whether the indicated condition is satisfied.

For at least these reasons, Claim 1 is respectfully submitted to be patentable over Nagami.

Independent Claims 27, 30, 31, and 32 include analogous recitations to Claim 1, and are submitted to be patentable over Nagami for at least the reasons explained for Claim 1.

Dependent Claims 2-26 and 28-29 are patentable at least per the patentability of the independent claims from which they depend. Moreover, these dependent claims are respectfully submitted to provide additional bases for patentability over Nagami, as will now be explained.

Dependent Claims 6-26 and 29 are Patentable Over Nagami

Claims 6-26 and 29 stand rejected under 35 U.S.C. §103(a) as unpatentable over Nagami. The Office Action provides the following bases for rejecting these claims:

In regard to dependent Claims 6-26, the claimed *at least one of specified annotations* set forth in Claims 6 through 26 would have been obvious to one of ordinary skill in the art at the time of the invention over Nagami's teaching (Col. 8, lines 39-55) because the "specified annotations" constitute nothing more than non-functional descriptive data. Since the claimed invention does not operate on this data, the data imparts no functionality, and is therefore obvious over any other data. (Office Action, Page 6.)

The Office Action appears to summarily reject these claims as "obvious over any other data" because the original claims recited "non-functional descriptive data." (Office Action, Page 6.) Applicants have amended Claims 6-10, 13-15, and 24-25 so that functional acts are now more clearly recited.

Amended Claim 6 recites that at least one of the inserted annotations requests clipping content from a document, and that the method includes clipping content from the target document based on the at least one of the inserted annotations. Nagami does not disclose clipping content from a document based on an inserted annotation requesting such clipping.

Amended Claim 7 recites that at least one of the inserted annotations describes changes to one or more form elements in a document, and that the method includes changing one or more form elements in the target document based on the at least one of the inserted annotations. Nagami does not disclose changing form elements in a document based on an inserted annotation requesting such changes.

Amended Claim 8 recites that at least one of the inserted annotations prescribes one or more nodes to be replaced in a document, and that the method includes replacing one or more nodes in the target document based on the at least one of the inserted annotations. Nagami does not disclose replacing nodes in a document based on an inserted annotation requesting such replacement of nodes.

Amended Claim 9 recites that at least one of the inserted annotations specifies one or more (attribute name, attribute value) pairs to be inserted into a document, and that the method includes inserting one or more (attribute name, attribute value) pairs in the target document based on the at least one of the inserted annotations. Nagami does not disclose inserting (attribute name, attribute value) pairs in a document based on an inserted annotation requesting such insertion.

Amended Claim 10 recites that at least one of the inserted annotations specifies fine-grained transcoding preferences to be inserted into a document, and that the method includes inserting fine-grained transcoding preferences in the target document based on the at least one of the inserted annotations. Nagami does not disclose inserting fine-grained transcoding preferences in a document based on an inserted annotation requesting such insertion.

Amended Claim 13 recites that at least one of the inserted annotations prescribes Hypertext Markup Language ("HTML") syntax to be inserted into a document, and that the method includes inserting HTML syntax in the target document based on the at least one of the inserted annotations. Nagami does not disclose inserting HTML syntax in a document based on an inserted annotation requesting such insertion.

Amended Claim 14 recites that at least one of the inserted annotations prescribes rendered markup language syntax to be inserted into a document, and that the method includes inserting rendered markup language syntax in the target document based on the at least one of the inserted annotations. Nagami does not disclose inserting rendered markup language syntax in a document based on an inserted annotation requesting such insertion.

Amended Claim 15 recites that at least one of the inserted annotations specifies a location where one of the specified annotations is to be inserted into a document, and that the method includes selectively inserting a specified annotation at a location in the target document that is specified by an attribute of that annotation. Nagami does not disclose inserting a specified annotation at a location in the target document that is specified by an attribute of that annotation.

Claim 24 further defines that a definition of a particular one of the specified annotations states at least one (key, value) pair as a condition that indicates when the particular annotation is to be inserted into a document. Accordingly, Claim 24 further defines a condition under which a particular annotation is to be inserted into a document. As was previously explained, Nagami does not disclose selective insertion of annotations based on defined conditions.

Claim 25 contains analogous recitations to Claim 24, and is patentable over Nagami for substantially the same reasons.

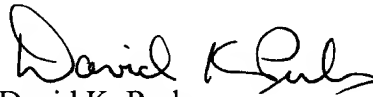
For at least these reasons, Claims 6-26 and 29 are respectfully submitted to be patentable over Nagami.

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Filed: July 20, 2001
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CONCLUSION

In light of the above amendments and remarks, Applicants respectfully submit that the above-entitled application is now in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested.

Respectfully submitted,



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